

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael Neumann
Application Number: 10/566,379
Filing Date: 01/26/2006
Group Art Unit: 3637
Examiner: Andres F. Gallego
Title: COOLING DEVICE WITH CERAMIC STORAGE
COMPARTMENTS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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REPLY BRIEF

This is a reply to the Examiner's Answer mailed May 3, 2010.

In the "Response to Argument" section in the Examiner's Answer, the Examiner maintains that "a ceramic material is not inherently a non-glass ceramic, since [it is] well known in the art that not all ceramics necessarily are non-glass." As discussed in the Appeal Brief, however, since it is an objective of the present invention to overcome disadvantages of prior art *glass* products, it is clear that a non-glass ceramic material is intended/inherent in the description. "To satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure, expressly **or inherently**, to make it clear to one skilled in the art that the appellant was in possession of the subject matter claimed" (emphasis added). *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655, 662 (C.C.P.A. 1979). See also, *Callicrate v. Wadsworth Manufacturing, Inc.*, 427 F.3d 1361, 77 USPQ2d 1041, 1051-52 (Fed. Cir. 2005)("[A] patent specification may sufficiently enable a feature under § 112, first paragraph, even if only the background section provides the enabling disclosure.").

Moreover, the Examiner's Answer refers to Appellant's arguments with regard to

glass being a raw material in the production of porcelain. Although glass “is not an exclusive or required ingredient to its production,” unless there is some disclosure to support the contrary, reference to porcelain is insufficient to meet the claimed non-glass ceramic material. This is readily comparable to the present specification, which specifically references overcoming the drawbacks of glass materials.

The Examiner’s Answer further provides that “the Examiner is allowed to take the commonly known meaning of ‘ceramic material’ when interpreting the claim language.” It is improper under U.S. patent law, however, to “take the commonly known meaning” of a term when an alternative meaning or specific meaning has been defined in the specification. In this context, as discussed previously, by referencing the disadvantages of glass materials and by describing an objective to overcome such disadvantages, it is clear that Appellant intended to define a non-glass ceramic material. In this context, see *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 66 USPQ2d 1517, 1520 (Fed. Cir. 2003):

The written description must be examined in every case, because it is relevant not only to aid in the claim construction analysis, but also to determine if the presumption of ordinary and customary meaning is rebutted. See *Renishaw PLC v. Marposs Societe per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998). The presumption will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth a definition of the term different from its ordinary and customary meaning. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). **The presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.** See *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327, 63 USPQ2d 1374, 1382 (Fed. Cir. 2002). Emphasis added.

Since Appellant has clearly disavowed a glass material, Appellant submits that the presumption of ordinary and customary meaning has been rebutted.

With regard to claims 15-20, the Examiner's Answer recognizes that glass is a common ingredient used in the production of porcelain. As such, unless the "Period Arts" article specifically disavows a glass material, for instance as in the present specification, the reference is inappropriate in the present application and falls short of the claimed invention.

For at least the above reasons and the reasons set forth in the Appeal Brief, reversal of the rejections is respectfully requested.

Respectfully submitted,

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